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In the Supreme Court of the United States

October Term, 1964.

No. [redacted] 11

WILLIAM T. GRAHAM, AND GRAHAM PLOW, INC., *Petitioners,*

vs.

JOHN DEERE COMPANY OF KANSAS CITY, AND DEERE & COMPANY, *Respondents.*

On Writ of Certiorari to the United States Court of Appeals for the Eighth Circuit.

BRIEF ON BEHALF OF PETITIONERS.

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INDEX.

PAGE

Opinions Below 1

Jurisdiction 2

Constitutional and Statutory Provisions and Procedure Rule Involved 3

Questions Presented for Review 5

Statement of the Case 7

Summary of Argument 15

Argument 19

A. The Present Patent Statute and Its Background.... 19

B. The Test of Patentability Applied by the Court of Appeals for the Eighth Circuit is in Conflict with the Requirements of the Statute 25

C. The Patent in Suit 29

D. The Respondents' Structures 32

E. The Prior Art 36

F. The Patent in Suit Meets the Statutory Requirements for Patentability 40

Conclusion 45

Table of Cases Cited.

Aro Manufacturing Co. v. Convertible Top Replacement Co., 377 U. S. 476, 492; 12 L. Ed. 2d 457, 472 (1964) 25, 26

Samuel Berman v. Andrew Parker, 348 U. S. 26, 32 (1954) 24

PAGE

Cornell v. Adams Engineering Company, 258 F. 2d 874 (5th Cir. 1958) 13
Cuno Engineering Corporation v. Automatic Devices Corporation, 314 U. S. 84, 91 (1941) 20, 22, 25

Diamond Rubber Company v. Consolidated Rubber Tire Company, 220 U. S. 428, 441 (1911) 36
Dunbar v. Meyers, 94 U. S. 187, 197-200 (1876) 19

Eibel Process Company v. Minnesota & Ontario Paper Company, 261 U. S. 45, 63 (1923) 19
Entron of Maryland, Inc. v. Jerrold Electronic Corp., 295 F. 2d 670, 674 (4th Cir. 1961) 26, 42
Expanded Metal Co. v. Bradford, 214 U. S. 366-381 (1909) 19, 43

Fisch v. Gould, 246 F. 2d 5 (3rd Cir. 1957) 25

General Bronze Corp. v. Cupples Products Corp., 189 F. 2d 154, 161 (8th Cir. 1951) 13, 27
Graham v. Cockshutt Farm Equipment, 256 F. 2d 358 (5th Cir. 1958) 2, 7, 8, 36, 41, 42
William T. Graham et al. v. Jeoffroy Mfg., Inc., et al., not reported (D. C. Tex. N. D.) 2, 7
Great Atlantic & Pacific Tea Company v. Supermarket Equipment Corporation, 340 U. S. 147 (1950) 20, 22, 25
Guiberson Corporation v. Equipment Engineers, 252 F. 2d 431 (5th Cir. 1958) 35

Halliburton Oil Well Cementing Company v. Walker, 329 U. S. 1 (1946) 44
Hotchkiss v. Greenwood, 52 U. S. 248 (1850) 19, 22, 23

Jeoffroy Mfg. v. Graham, 206 F. 2d 772 (5th Cir. 1953) 2, 37
Jeoffroy Mfg. v. Graham, 219 F. 2d 511 (5th Cir. 1955) .. 2, 7
Jeoffroy Mfg. v. Graham, 256 F. 2d 360 (5th Cir. 1958) .. 2

Kurtz v. Belle Hat Lining Co., 280 F. 277 (2nd Cir. 1922) .. 35

PAGE

Lincoln Engineering Company of Illinois v. Stewart-Warner Corporation, 303 U. S. 545, 549 (1938) 20
Lyon v. Bausch & Lomb Optical Co., 224 F. 2d 530, 535-536 (2nd Cir. 1955) 23

McClain v. Ortmayer, 141 U. S. 419, 425-429 (1891) 19
Makenzie v. Hare, 239 U. S. 299, 308 (1915) 24
Marvel Specialty Company v. Bell Hosiery Hills, Inc., 330 F. 2d 164, 169-171 (4th Cir. 1964) 23
Mercoid Corporation v. Mid-Continent Investment Company, 320 U. S. 661 (1944) 26
Mercoid Corporation v. Minneapolis-Honeywell Regulator Company, 320 U. S. 680 (1944) 26
Minnesota Mining & Manufacturing Company v. Shuger, 132 F. Supp. 640 (D. Md. 1955) 35
Monroe Auto Equipment Company v. Heckethorn Manufacturing & Supply Company, 332 F. 2d 406, 410-411 (6th Cir. 1964) 23

Newburgh Moire Company v. Superior Moire Company, 237 F. 2d 283 (3rd Cir. 1956) 25

Otto v. Koppers Company, 246 F. 2d 789, 801 (4th Cir. 1957) 40

Pacific Contact Laboratories v. Solex Laboratories, 209 F. 2d 529 (9th Cir. 1953) 25
R. M. Palmer Company v. Luden's, 236 F. 2d 496 (3rd Cir. 1956) 25
Parker Appliance Co. v. Irvin W. Masters, 94 F. Supp. 72, Aff. 193 F. 2d 180 (9th Cir. 1951) 44
Plax Corporation v. Precision Extruders, 239 F. 2d 792 (3rd Cir. 1957) 25

Refrigeration Patents Corporation v. Stewart-Warner Corporation, 159 F. 2d 972 (7th Cir. 1947) 44
Reiner v. I. Leon Co., 285 F. 2d 501, 503-504 (2nd Cir. 1960) 23

PAGE

Washington Market Company v. Hoffman, 101 U. S. 112 (1879) 24
Wyott Mfg. Company v. Doran Coffee Roasting Company, 160 F. Supp. 644 (D. Col. 1958) 35

Statutes.

62 Stat. 931, 28 U. S. C. § 1338 (1948) 2
62 Stat. 928, 28 U. S. C. § 1254 (1948) 2
66 Stat. 797, 35 U. S. C. § 101 (1952) 3, 20
66 Stat. 797, 35 U. S. C. § 102 (1952) 3, 20
66 Stat. 798, 35 U. S. C. § 103 (1952) 4, 20-23
66 Stat. 812, 35 U. S. C. § 282 (1952) 4
Fed. R. Civ. P. 52 5
U. S. Const., Art. I, § 8, cl. 8 3

Publications.

P. J. Federico, Commentary on the New Patent Act, prefacing text of U. S. Code Annotated, Title 35, §§ 1 to 110 (1954) 24
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In the Supreme Court of the United States

October Term, 1964.

No. 580.

WILLIAM T. GRAHAM, AND GRAHAM PLOW, INC., *Petitioners,*

vs.

JOHN DEERE COMPANY OF KANSAS CITY, AND DEERE & COMPANY, *Respondents.*

On Writ of Certiorari to the United States Court of Appeals for the Eighth Circuit.

BRIEF ON BEHALF OF PETITIONERS.

OPINIONS OF THE COURTS BELOW.

(a) Opinion of the District Court (R. 17-34) reported 216 F. Supp. 272.

(b) Opinion of the United States Court of Appeals for the Eighth Circuit (R. 923), 333 F. 2d 529.

The patent here in suit has also been before other courts in the following cases:

(a) *William T. Graham et al.* v. *Jeoffroy Mfg., Inc., et al.* (D. C. Tex. N. D.) opinion not reported.

(b) *Jeoffroy Mfg.*, v. *Graham*, 219 F. 2d 511 (5 Cir., 1955), holding patent valid and infringed. Certiorari denied, 350 U. S. 826. (See Appendix D Petition for Writ of Certiorari this case.)

(c) *Jeoffroy Mfg., Inc. et al.* v. *William T. Graham et al.* (D. C. Tex. N. D) contempt proceeding, opinion not reported.

(d) *Jeoffroy Mfg.*, v. *Graham*, 256 F. 2d 360 (5 Cir., 1958) (contempt affirmed). (See Appendix E Petition for Writ of Certiorari this case.)

(e) *Graham* v. *Cockshutt Farm Equipment*, (D. C. Tex. N. D.) opinion not reported.

(f) *Graham* v. *Cockshutt Farm Equipment*, 256 F. 2d 358, (5 Cir., 1958) holding patent valid but not infringed. (See Appendix F Petition for Writ of Certiorari this case.)

JURISDICTION.

This is a suit arising under the Patent Laws of the United States, Title 28, Section 1338, of the United States Code. Statutory provision believed to sustain the jurisdiction is Title 28, Section 1254, of the United States Code. The date of the decree of the United States Court of Appeals for the Eighth Circuit is June 18, 1964, (R. 931) and a petition for rehearing thereof was denied July 13, 1964 (R. 939).

CONSTITUTIONAL AND STATUTORY PROVISIONS AND PROCEDURE RULE INVOLVED.

This case involves Clause 8 of Section 8, Article I of the Constitution of the United States, and Sections 101, 102, 103 and 282 of Title 35 of the United States Code, and Federal Rule of Civil Procedure Number 52, all of which are set forth in the following:

CONSTITUTION.

Article I, § 8, Clause 8.

The Congress shall have the power * * * to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries; ***

STATUTES.

Title 35 U. S. C.

§ 101. Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

§ 102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

§ 103. Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

§ 282. Presumption of validity; defenses.

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party establishing it. * * *

FEDERAL RULES OF CIVIL PROCEDURE.

Rule 52. Findings by the Court.

(a) Effect. In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusion of law thereon and direct the entry of the appropriate judgment; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. The findings of a matter, to the extent that the court adopts them, shall be considered as the findings of the court. If an opinion or memorandum of decision is filed, it will be sufficient if the findings of fact and conclusions of law appear therein. Findings of fact and conclusions of law are unnecessary on decisions of motions under Rules 12 or 56 or any other motion except as provided in Rule 41(b).

QUESTIONS PRESENTED FOR REVIEW.

1. Did the Graham Patent No. 2,627,798 meet the Constitutional and statutory requirements for patentability?

2. Did the Court of Appeals for the Eighth Circuit in holding the Graham Patent No. 2,627,798 invalid, apply a test as to patentability contrary to the conditions and requirements for patentability expressly set forth in Title 35 of the United States Code, Sections 101, 102 and 103?

3. Did the Court of Appeals for the Eighth Circuit err in suggesting the absence of details of function or result

in a specification or claims of a patent is a proper ground for declaring the Graham Patent invalid when the patent clearly discloses the structure?

4. Did the Court of Appeals for the Eighth Circuit err in holding the presumption of validity of the Graham Patent was weakened by applicable prior art not cited by the Patent Office when the additional cited prior art was not found to be more pertinent?

STATEMENT OF THE CASE.

The patent in suit was first involved in litigation in the District Court for the Northern District of Texas in the case of *William T. Graham et al.* v. *Jeoffroy Mfg., Inc., et al.* where the patent was held to be invalid for double patenting. On appeal to the United States Court of Appeals for the Fifth Circuit, the decision of the District Court was reversed and patent was held valid and infringed by the devices there involved, 219 F. 2d 511. Certiorari denied, 350 U. S. 826. (Appendix D Petition for Writ of Certiorari this case.)

The patent was again before the same District Court in the Northern District of Texas in the case of *Graham* v. *Cockshutt Farm Equipment,* where the patent was held valid and not infringed by the devices there involved. On appeal to the United States Court of Appeals for the Fifth Circuit, the decision of the District Court was affirmed, 256 F. 2d 358. (Appendix F Petition for Writ of Certiorari this case.)

In the *Jeoffroy* case, *supra,* the action was commenced as a declaratory judgment action relative to a Graham Patent, No. 2,493,811, which had been held valid and infringed in earlier litigation. Jeoffroy had changed its structure and sought a declaration of non-infringement. By counterclaim, Graham brought in patent No. 2,627,798 and urged infringement of both 811 and 798 patents. The District Court considered the 811 patent a pioneer patent and of such broad scope that the new Jeoffroy structure (Pls. Ex C.), which could not be distinguished in any material respect from the 798 patent, infringed said 811 patent and that said 798 patent was invalid for double patenting. The Court of Appeals for the Fifth

Circuit held that the 811 patent was not entitled to such a broad scope, was not infringed by the new Jeoffroy structure, that the 798 patent was valid and entitled to limited protection. The Court further stated:

> "Other factors strongly influencing and, we think reinforcing our conclusion as to the validity of 798 are: (1) that presumption of validity which attends the grant of a patent by the Patent Office where, as here, it appears to have fully considered and distinguished the very prior art patents here principally relied upon as anticipation *(Southern States Equip. Corp.* v. *USCO Power Equip. Corp., supra)*; (2) the rule that the burden of proof of invalidity is on the party seeking to upset a patent's prima facie validity from issuance, and that any reasonable doubt will be resolved against him, (3) the further rule, long recognized by this Court, that an improvement combination is patentable even though its constituent elements are singly revealed by the prior art, where, as here, it produces an old result in a cheaper and otherwise more advantageous way; * * *

In the *Cockshutt* case the Court of Appeals for the Fifth Circuit recognized that it had the power to change its position as to the validity of the 798 patent and concluded after careful consideration that its decision previously made as to the validity of the patent should stand. Of particular note is the fact that in that case all of the alleged prior art that is in this case before this Court was considered in the Cockshutt case, in which the Court of Appeals for the Fifth Circuit held the patent in suit valid. (Stipulation item 7, R. 15.)

The patent in suit (Pls. Ex. A; R. 577-587) relates to a structure used in chisel plowing. In such plowing, chisel tools are secured to the lower ends of shanks carried on mobile frames which, when moved over the

ground with the tools extending therein, results in the chisel tools breaking the soil and forming small alternate ridges in furrows having exposed surfaces and leaving vegetation and other emulsive material normally occurring on the field on top of the ground. This was found to be particularly desirable in the wheat country as it tended to reduce erosion of the soil by wind and rain. In chisel plowing in the plains country wherein the ground was substantially free of rocks, the upper forward ends of shanks were rigidly secured to plow beams or frames, the shanks extending rearwardly therefrom and curving downwardly to the end mounting the chisel tool, and any resiliency or flexing of the shanks was only in the portions that extended rearwardly from the clamps. Bending of the shanks resulted in maximum stress in the shanks at the point immediately rearward of the clamp. When such structures were used in the farming areas having rocky conditions, the plows were bent and broken and the structures were not satisfactory (R. 241). When the tools are pulled through the ground by a tractor and a tool on a shank strikes a buried rock, the structure may be subjected to extreme shocks. The forces on the chisel tool could result in forces on the forward ends of the shanks up to 4,000 pounds or so (R. 409).

Graham had provided a structure for a solution to the problem of chisel plowing in rocky areas and had been issued the Graham 811 patent thereon. In endeavoring to find other structures that would also provide a solution, Graham devised the structure of the patent in suit (Pls. Ex. A; R. 577-587) which, while entitled "Clamp for Vibrating Shank Plows," discloses and claims a structure mounting tool carrying shanks on mobile frames for chisel plowing particularly in rocky areas where the structure is subjected to severe shocks by the tools striking rocks or

immobile objects. The invention provides a structure that has an ability to flex for absorbing the shock so as to eliminate or reduce breakage or damage to the structure.

The present case originated by petitioners bringing suit against respondents alleging infringement of Claim 1 of the 798 patent by Deere 650 series clamps (Pl. Ex. I) and Claims 1 and 2 by Deere 100 series clamps (Pl. Ex. J). The claims are:

> Claim 1. In a plow having a frame and a ground working tool provided with a shank adapted to rock relatively to the frame when the plow is in operation in a forward direction, a mounting for pivotally attaching and supporting the shank of the ground working tool to a transverse member of the frame, the mounting including a fixed member adapted to be fixed to the transverse member of the frame and having a longitudinally extending underface terminating forwardly of the transverse member to which said mounting is adapted to be fixed, the fixed member having ears extending rearwardly from said underface at the sides thereof, a shank attaching member having an elongated plate portion provided with an upper face corresponding with and normally in contact with said underface of the fixed member and provided with a longitudinally extending underface in engagement with a corresponding upper face of the shank whereby the plate portion of the shank attaching member is between the shank and the fixed member, means connecting the elongated plate portion with the shank for maintaining the upper face of the shank in constant continuous contact with the underface of said plate portion of the shank attaching member, a transverse pin pivotally connecting the shank attaching member to the fixed member at the rear ends of said normally contacting faces and whereon the shank attaching member pivots upon rocking movement of the shank, a coil spring having one end seated on the forward end of the fixed mem-

ber, and means having connection with the forward end of the shank and with the other end of the coil spring whereby the spring yieldably maintains said normal contact of the upper face of the plate portion of the shank attaching member with the underface of the fixed member to maintain the normal plowing depth of the ground working tool.

Claim 2. In a plow having a frame and a ground working tool provided with a shank adapted to rock relatively to the frame when the plow is in operation in a forward direction, a mounting for pivotally attaching and supporting the shank of the ground working tool to a transverse member of the frame, the mounting including a fixed member adapted to be fixed to the transverse member of the frame and having a longitudinally extending underface terminating forwardly of the transverse member to which said mounting is adapted to be fixed, the fixed member having ears extending rearwardly from said underface at the sides thereof, a shank attaching member having an elongated plate portion provided with an upper face corresponding with and normally in contact with said underface of the fixed member and provided with a longitudinally extending underface in engagement with a corresponding upper face of the shank whereby the plate portion of the shank attaching member is between the shank and the fixed member, said shank attaching member having a lug extending upwardly between said ears of the fixed member and disposed at the rear end of the plate portion and above the plane of the underface of the fixed member, said shank attaching member having depending means embracing the shank at the rear end of said plate portion, a bolt connecting the forward end of the plate portion with the forward end of the shank and cooperating with the shank embracing means in maintaining the upper face of the shank in constant continuous contact with the underface of said plate portion, a pivot pin extending transversely through said lug and carried by the

> ears with the axis thereof above the plane of the underface of the fixed member whereby the normally contacting face of the shank attaching member immediately moves out of contact with and away from the face of the fixed member when the shank attaching member pivots upon rocking movement of the shank, a coil spring having one end seated on the forward end of the fixed member, and means having connection with the forward end of the shank and with the other end of the coil spring whereby the spring yieldably maintains said normal contact of the upper face of the plate portion of the shank attaching member with the underface of the fixed member.

In the District Court, following a trial involving eight days, in which the structures and moving pictures of plows in operation were shown and the court clearly advised in the premises and the submission of extensive briefs and proposed findings of fact, judgment was rendered holding the patent valid and infringed. Specifically, the Trial Court found (216 F. Supp. 272, 278):

> "The disclosures of the prior art not cited by the Patent Office * * * are similar to some of the patents relied upon by the Patent Office Examiner. * * * Hence the statutory presumption of validity of the Graham patent in suit is not weakened or destroyed" (Finding XI; R. 27).
>
> "* * * The particular arrangement of the elements disclosed by 798 is not present in any single reference or as a whole" (Finding XII; R. 28).
>
> "An improved functional result is obtained by the Graham 798 structure * * *" (Finding XIII; R. 28).
>
> "* * * 798 patent is an improvement patent. * * * Taken as a whole, the Graham 798 structure is sufficiently different in the operative relationship of the shank and pivoted member with a slight but significant difference in the flexing of the forward part

of the shank that it is not found in the prior art so that the Graham 798 patent involves invention" (Finding XIV; R. 28).

"The differences between the Graham 798 patent and the prior art are such that the Graham 798 structure * * * would not have been obvious at the time Graham made his invention to a person having ordinary skill in the art of agricultural implements and other related arts * * *" (Finding XV; R. 28-29).

"It demanded invention of the quality required by the patent statutes, Title 35, U. S. C., to produce the structure of the Graham 798 patent * * *" (Finding XVI; R. 29).

Respondent duly filed an appeal on July 17, 1963, and after the filing of briefs and oral argument the Court of Appeals for the Eighth Circuit reversed the trial court as to the validity of the Graham 798 patent but did not consider the question of infringement. Although the Court of Appeals reversed the trial court, it did not controvert the findings of fact below as to the improved functional result. It reversed primarily on the ground that the trial court had not applied a proper legal standard in determining the validity, *because the trial court did not find a new result.* The Court of Appeals set forth its test of patentability and also clearly stated that its test was different than that applied by the Court of Appeals of the Fifth Circuit. The test applied by the Eighth Circuit was stated by quoting with approval the following:

"The bringing together of old elements in a mechanism involving no new principle, to produce an old result, however skillfuly done, even though the result marks an advance in efficiency and utility, is but an exercise of mechanical skill and not invention." *General Bronze Corp.* v. *Cupples Products Corp.*, 8 Cir., 189 F. 2d 154, 161 (1951). (R. 930).

The Court of Appeals then referred to the test of the Fifth Circuit, as follows:

> "Unlike our court, the Fifth Circuit has 'long recognized * * * that an improvement combination is patentable even though its constituent elements are singly revealed by the prior art, where * * * it produces an *old result in a cheaper and otherwise more advantageous way.*' (Emphasis supplied.) 219 F. 2d at 519. For other recognition by the Fifth Circuit of the 'old result in a more efficient and economical way' see, *Cornell* v. *Adams Engineering Company, supra,* 258 F. 2d at 875-876." (R. 930).

The Court of Appeals then clearly showed the application of the Eighth Circuit test in the following:

> "Here, the trial court couched its Finding XV rather precisely in the statutory standard of invention found in 35 U. S. C. § 103, and found that the 798 Patent structure would not have been obvious at the time it was made to a person having ordinary skill in the art. But, other findings of the court lay stress on 'an *improved* functional result,' and nowhere does the court find any new or significantly different result. Seemingly, the trial court failed to apply the more exacting standard which in our view is implicit in the teachings of the Supreme Court in *Cuno Engineering Corporation, supra,* 314 U. S. 84, and *Great A. & P. Tea Co., supra,* 340 U. S. 147, and which we have applied in numerous cases subsequent thereto." (R. 930-931).

To bolster its position, the Court of Appeals referred to the significance of the difference in the flexing of the structure of the patent in suit from that of the prior art and held that it did not involve inventive genius but the reason for holding the patent invalid was still that there was no new result. This is clear in the following:

"While perhaps more efficient, the inversion of the parts so as to allow the shank to flex downwardly away from the plate above it did not bring about a significantly new or different result, and would have been obvious to a person having ordinary skill in the art."

SUMMARY OF ARGUMENT.

A. The Present Patent Statute and Its Background.

The constitution empowers Congress to enact statutes relating to issuance of patents. Prior to the 1952 Act, Congress had never declared any standard by which patentability could be determined. There had developed from judicial opinions a so-called "standard of invention" that was recognized by the revisers as causing great difficulty in determining what was patentable. In composing the bills that culminated in enactment of Sections 101, 102 and 103 of the 1952 Act, the revisers sought to eliminate the vague "standards" and stabilize the law. The legislature is the prime guardian of the public interest served by the patent system. Congress has spoken and has defined for the first time a statutory requirement for *patentability*. The wording of the statute is clear and should be followed. It overrules the various "standards of invention" stated in prior judicial opinions. The directive of the statute is to determine whether the invention "would have been obvious" on the basis of the differences between it and the prior art and the ordinary skill of a person in the art as of the time of the invention.

B. The Test of Patentability Applied by the Court of Appeals for the Eighth Circuit is in Conflict with the Requirements of the Statute.

The Court of Appeals is applying standards on tests as to patentability based upon opinions in the Cuno and A. & P. cases. Both of those opinions were prior to the 1952 Act. It in effect is holding that if the patent structure is a combination of old elements and does not produce a new result, the patent is invalid. If the result is an advance in efficiency and utility or an improved functional result, then it is but an exercise of mechanical skill and invalid by the view of said court. The statute has no requirement for determining patentability which requires the invention to produce a new result. The Court did not recognize that a different arrangement of old elements producing an improved result may be patentable if not obvious to a person having ordinary skill in the art. It also disregarded Rule 52 of the Federal Rules of Civil Procedure and did not properly consider the trial court's finding regarding the presumption of validity.

C. The Patent in Suit.

The 798 structure is a mounting for shanks having chisels for plowing in rocky areas. It includes a body member with a plate member hinged thereon. The shank extends along the plate and is connected to it by a bolt and nut at the forward end of said plate. When the chisel strikes a rock the forces cause the forward end of the plate to swing downwardly. Also the portion of the shank along the plate tends to flex or bow away from the plate and absorb some of the shock. This flexing was not possible with the prior art, as in the prior devices the

forces tighten the shank against the plate and prevent the shank flexing in that area.

D. The Respondents' Structures.

Respondents' structures were designed with full knowledge of the patent in suit and the prior art. Their patent department advised the first designs infringed the patent. Only minor changes that did not change operation were incorporated in the devices they marketed. The engineer admitted the structure gave a better stress arrangement. The respondents cast aside those structures that were available from the prior art because they coveted the advantages that resulted from the advance provided by the 798 structure. This should be evidence that the 798 device was new, novel, represented progress in the art and met the statutory requirements for a valid patent.

E. The Prior Art.

All of the prior art, both patents and uses relied upon by respondents, was before the Court of Appeals for the Fifth Circuit in a case wherein the patent in suit was held to be valid. The trial court in this case found the devices of the art not cited by the Patent Office was similar to some that were cited and the Court of Appeals for the Eighth Circuit did not controvert that finding.

The prior art showed an arrangement of a shank and hinged plate member wherein forces acting on the shank tended to bend and hold the shank against the plate and prevent flexing in that portion of the shank. In the patent in suit the forces tended to bow the shank away from the plate providing flexing and shock absorption. While the prior art disclosures were available for over fifty years, not even those skilled in the art seeking to solve the

problem of plowing in rocky areas, conceived of a structure that would flex and perform like the 798 patent.

F. The Patent in Suit Meets the Statutory Requirements for Patentability.

The statutory requirement that the patentable device be novel, useful and not obvious to a person having ordinary skill in the art was met. The Court of Appeals recognized the 798 structure was a different arrangement from those of the prior art; that it was new. It was useful. A large number of devices coming under the patent were sold by Jeoffroy. There was no showing of any condition under Section 102 of the statute to prevent patentability. There was a problem in plowing in rocky areas. The prior art relied upon by respondents was the same arrangement that had been disclosed in Rix and available to the industry for fifty years, but not even those of exceptional skill in the art could conceive of the arrangement of the 798 patent.

There is no requirement in the statute that the device must provide a new result. The holding by the Court of Appeals that when the device was found to provide an improved functional result it was obvious to a person skilled in the art, is not in accordance with the statute.

ARGUMENT.

A. The Present Patent Statute and Its Background.

Patents in the United States exist only by virtue of statutes enacted by Congress pursuant to the enumerated power set forth in Article 1, Section 8 of the Constitution. The statutes enacted by Congress require that the invention to be patentable must be new. While none of the predecessor statutes to the 1952 Act set forth any statutory "Standard of Invention" as a condition for patentability, it has long been recognized that in order to have a sound patent system, the patentable invention must have more than bare novelty. Patents should not be granted on those inventions which would arise spontaneously given the need or desire for them. The requirement that patentable invention be more than the work of a skilled mechanic was approved by the Supreme Court in *Hotchkiss* v. *Greenwood,* 52 U. S. 248 (1850). That decision stated the requirement for patentable invention as follows:

> "* * * For unless more ingenuity and skill in applying the old method * * * were required than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitutes essential elements of every invention. In other words, the improvement is the work of the skilled mechanic, not that of the inventor." 52 U. S. at 266.

Generally in the ensuing years this Court applied this requirement with some verbal variances. See e.g., *Dunbar* v. *Meyers,* 94 U. S. 187, 197-200 (1876); *McClain* v. *Ortmayer,* 141 U. S. 419, 425-429 (1891); *Expanded Metal Co.* v. *Bradford,* 214 U. S. 366-381 (1909); *Eibel Process*

Co. v. *Minn. & Ontario Paper Co.*, 261 U. S. 45, 63 (1923). In more recent years the terminology and associated discursive comments employed by this and other courts relative to the delineation of the requirements for patentability in certain cases has differed markedly from that of earlier cases. In fact, the requirements finally evolved into a so-called "standard of invention." See *Lincoln Engineering Co., of Ill.*, v. *Stewart Warner Corp.*, 303 U. S. 545, 549 (1938); *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 91 (1941). *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147 (1950).

It would appear from some opinions that the thought was that if the item was an "invention," then it was patentable, and if it was not patentable, then it was not an "invention." Invention is, however, merely something that has been found out or devised or discovered. For example, a thing may be invented over and over by the use of inventive faculties or by inventive acts by different originators but the subsequent things are not patentable for want of novelty. The question of patentability should not be the degree of inventive skill or whether the device meets some indefinite "standard of invention." It should be whether under the statute it is patentable.

Prior to 1952 Congress had never declared any standard by which patentability could be determined. However, in the late 1940's Congress considered codification of Patent Laws and enactment of statutory standards. In preparing the statute, the revisers recognized that great difficulty had always existed in the law as to what was patentable, because to a large extent the so-called standards have been indefinite and subjective. The revisers sought to eliminate such vague standards and stabilize the law. These efforts culminated in enactment in 1952 of Sections 101, 102 and

103 of Title 35 of the United States Code, *supra*, pages 4, 5.

As noted in both the Senate and House reports on the subject legislation, "Section 101 sets forth the subject matter that can be patented, 'subject to the conditions and requirements of this title.' The conditions under which a patent may be obtained follow, and Section 102 covers the condition relating to novelty" (S. Rep. No. 1979, 82nd Cong., 2nd Sess. 5, 1952); (H. R. Rep. No. 1923, 82nd Cong., 2nd Sess. 6, 1952). The Senate and House reports also stated that there were changes in substantive statutory law and that a major change or innovation consisted in incorporating a requirement for patentability in Section 103. More specifically, with respect to Section 103, the reports state:

> "Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of the Courts and in writings. Sec. 103 states this requirement in the title. It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section 102. If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented."

Section 103 says that what is patentable must not have been obvious to one of ordinary skill in the art involved

at the time the invention was made. Clearly, this is a parallel to that requirement set down in the doorknob case of *Hotchkiss* v. *Greenwood, supra.* This section of the statute does not provide a "standard of invention." It is not called a requirement of invention. The presence or absence of invention is not mentioned. The use of the term "invention" was apparently carefully avoided and certainly the last sentence of Section 103 clearly eliminated any requirement that the new device reveal the flash of creative genius which some courts required for validity after this Court's decision in *Cuno Engineering Corp.* v. *Automatic Devices Corp.,* 314 U. S. 84 (1941).

This Patent Act of 1952 came after the *Great A. & P. Tea Company* v. *Supermarket Equipment Corp.* case which was decided in 1950 and the Court of Appeals of the Eighth Circuit is admittedly applying tests or standards based on the opinions in said Cuno and A. & P. cases. More important, however, the Court of Appeals for the Eighth Circuit applies a test that requires a new result. By its test if the device is different from the prior art and provides the same result by a diferent manner or if it is merely a better result, it would not be patentable, or if patented the patent would be held invalid. There is nothing in the statute requiring that a patentable invention provide a new result. There is no requirement that there be a different result. The statute requires that the invention not be obvious at the time to a person skilled in the art. The invention is novel, if it meets the requirements of Section 102, and if it would not have been obvious to a person skilled in the art at the time of invention, it should be patentable under the statute. If it meets the requirements it is patentable if it produces an old result in a cheaper or otherwise more advantageous way as has

been held by the Court of Appeals of the Fifth Circuit in holding of the patent in suit valid.

Congress in Sections 101, 102 and 103 of the Patent Act of 1952 provided a statutory definition of the requirements for patentability. This was a change from the "standards of invention" of the judicial opinions expressed in the decades immediately preceding the Act. The Patent Act of 1952 was the expression of clear intent by Congress to return or restore the old requirement laid down in *Hotchkiss* v. *Greenwood, supra.* The enactment of Section 103 and its change was realistically appraised and appreciated by Judge Learned Hand in *Lyon* v. *Bausch & Lomb Optical Co.,* 224 F. 2d 530, 535-536 (2 Cir., 1955). Judge Hand again considered the statute in *Reiner* v. *I. Leon Co.,* 285 F. 2d 501, 503-504 (2 Cir., 1960), wherein he said:

> "We still cannot escape the conclusion—as we could not when *Lyon* v. *Bausch & Lomb Optical Co., supra,* was decided in 1955 — that Congress deliberately meant to restore the old definition and to raise it from a judicial gloss to a statutory command."

In applying the statute in *Marvel Specialty Company,* v. *Bell Hosiery Hills, Inc.,* 330 F. 2d 164, 169-171 (4 Cir., 1964), the court found that after distilling the mass of verbiage of other cases that had undertaken to set forth the "standard of invention," it had little to guide it and that it became necessary to start with the statute.

The Court of Appeals for the Sixth Circuit in *Monroe Auto Equipment Company* v. *Heckethorn Mfg. & Supply Company,* 332 F. 2d 406, 410-411 (6 Cir., 1964), recognized the difficulty of defining invention. It then turned to the statute and applied the test specified therein.

In many opinions the courts have written extensive dissertations seeking to interpret the language of the 1952

Patent Act. They would do well to look through the writings of certain men that aided in drafting the Act. Included in such writings are:

> "Commentary on the New Patent Act" by P. J. Federico, prefacing text of U. S. Code Annotated, Title 35, Patents, Section 1 to Section 110; also "Congressional Intent—or, Who Wrote the Patent Act of 1952" by Hon. Giles S. Rich, in Patent Procurement and Exploitation, BNA 1963, pp. 61-68; and "The Vague Concept of 'Invention' as Replaced by Section 103 of the 1952 Patent Act" by Hon. Giles S. Rich, Journal of the Patent Office Society, December, 1964, Vol. 46, pp. 855-876.

In regard to statutory interpretation, this Court has stated that "Whatever was said in the debates on the bill—preceding its enactment or during its enactment, must give way to its language * * *." *Makenzie* v. *Hare*, 239 U. S. 299 at 308 (1915) and that "The statute, ought upon the whole, be so construed that, if it can be prevented, no clause, sentence or word shall be superfluous, void or insignificant." *Washington Market Company* v. *Hoffman*, 101 U. S. 112 (1879). The language of Sections 101, 102 and 103 are clear and definite and the lower court should be instructed to look to the statute for the requirements of patentability and not seek through a maze of confusing and misleading verbiage. The Act itself distinctly recites the conditions and provisions.

While the public interest is dominant in the patent system, the legislature is the prime guardian of the public interest. This was recognized in *Berman* v. *Parker*, 348 U. S. 26 at 32 (1954):

> "Subject to specific constitutional limitations, when the legislature has spoken, the public interest has been declared in terms well nigh conclusive."

In the instant situation, there can be no doubt that Congress has spoken and has defined for the first time a statutory requirement for patentable invention. The wording of the statute is clear and should be followed. It overrules the various "standards of invention" stated in prior judicial opinions. Now in patent cases the court should recognize that under the statute there is no "standard of invention." The directive of the statute is to determine whether the invention "would have been obvious" on the basis of the differences between it and the prior art and the ordinary skill of a person in the art as of the time of the invention. These are the factors, and these alone, by which courts are to determine the existence of the requirements for patentability as defined in Section 103.

B. The Test of Patentability Applied by the Court of Appeals for the Eighth Circuit is in Conflict with the Requirements of the Statute.

The Court of Appeals in this case is admittedly applying tests or standards as to patentability based upon the opinions in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84 (1941) and the *Great A. & P. Tea Company* v. *Supermarket Equipment Corp.*, 340 U. S. 147 (1950). Both of those opinions were handed down before the Patent Act of 1952, and were overruled thereby. The lower courts have recognized that the "flash of genius" theory of the Cuno case (*supra*) was overruled. *Pacific Contact Labs.* v. *Solex Labs.*, 209 F. 2d 529 (9 Cir., 1953). *R. M. Palmer Co.* v. *Ludens*, 236 F. 2d 496 (3 Cir., 1956). *Newburgh Moire Co.* v. *Superior Moire Co.*, 237 F. 2d 283 (3 Cir., 1956). *Plax Corp.* v. *Precision Extruders*, 239 F. 2d 792 (3 Cir., 1957). *Fisch* v. *Gould*, 246 F. 2d 5 (3 Cir., 1957). This Court also has recognized that the 1952 Act

overruled prior decisions. The decision in *Aro Mfg. Co.* v. *Convertible Top Replacement Co.*, 377 U. S. 476, 492; 12 L. Ed. 457, 472 (1964); recognized that section 271 overruled in part the opinion as to contributory infringement in *Mercoid Corp.* v. *Mid Continent Investment Co.*, 320 U. S. 661 (1944) and *Mercoid Corp.* v. *Minneapolis-Honeywell Regulator Co.*, 320 U. S. 680 (1944).

Instead of adhering to a position it took after the Cuno case, *supra*, the Court of Appeals should first look to the statute and particularly to what constituted a major change or innovation in the statute where Congress for the first time set forth the requirements for patentability. The Court of Appeals paid lip service to the statute, but clearly throughout its opinion was applying a so-called standard wherein the patent on the mechanism would be invalid unless said mechanism produced a new result. It is submitted that the Constitutional Clause which enabled Congress to enact the patent statutes contained no standard for determining patentability which required the invention to produce a new result. The present statute, the Patent Act of 1952, sets out all of the requirements for patentability in the clearest possible form, 35 U. S. C. 101, 102 and 103. Section 101 says patentable inventions must be new and useful. Section 102 provides conditions for patentability and defines novelty, and Section 103 sets forth the other requirement, that the subject matter as a whole would not have been obvious at the time the invention was made to a person having ordinary skill in the art. Also this Section states that patentability shall not be negatived by the manner in which the invention was made. Nowhere in that statute is there any requirement that to be patentable an invention must produce a new result. As stated in *Entron of Maryland Inc.*, v. *Jerrold Electronic Corp.*, 295 F. 2d 670, 674 (4 Cir., 1961); "* * * the combi-

nation patent is not invalid for failure of its elements to demonstrate a 'new function'."

The Court of Appeals clearly stated its position when it quoted with approval from a prior opinion by that court in *General Bronze Corp.* v. *Cupples Products Corp.*, 8 Cir., 189 F. 2d 154, 161, rendered in 1951 before the present statute. The Court of Appeals referred to the trial court's finding that the 798 patent provided an improved functional result. In reference to that finding, the court italicized the word "improved" and again in reference to the trial court's finding, it emphasized the word "improved" stressing that the trial court did not find any new result. The real basis for the Court of Appeals holding the 798 patent invalid is shown in the part of the opinion that reads as follows:

> "Here, the trial court couched its Finding XV rather precisely in the statutory standard of invention found in 35 U. S. C. § 103, and found that the 798 Patent structure would not have been obvious at the time it was made to a person having ordinary skill in the art. But, other findings of the court lay stress on 'an *improved* functional result,' and nowhere does the court find any new or significantly different result. Seemingly, the trial court failed to apply the more exacting standard which in our view is implicit in the teachings of the Supreme Court in *Cuno Engineering Corporation, supra,* 314 U. S. 84, and *Great A. & P. Tea Co., supra,* 340 U. S. 147, and which we have applied in numerous cases subsequent thereto."

The Court of Appeals for the Eighth Circuit clearly refuses to recognize that a patentable invention is permitted under the statute when a different structure is devised to provide the same function and result. On the basis of that court's so-called "standard," an automobile

would not be a patentable invention over a wagon as they would both be vehicles on wheels to provide a common result, transportation over a road from one place to another. This "standard" would ignore the fact that the automobile would provide the transportation in a faster and more advantageous way.

Furthermore, an invention in a structure may have the same broadly identified elements and function to provide the same broad result as an old structure, but the association of the elements or arrangement thereof can be different, whereby in operation there is a difference in the action, and if the structure is new and novel and not obvious to a person skilled in the art at the time of invention, it should be patentable under the statute. However, in such a case the Court of Appeals for the Eighth Circuit, with its disregard of the statute, and by applying its old, outdated test would hold that the invented structure, producing an old result, even though skillfully done, and even though there was a marked advance in efficiency and utility, would because of the old result be "but an exercise of mechanical skill and not invention." In other words, the fact that it produced an old result would be conclusive that the patent would be held invalid in the Eighth Circuit.

The trial court in this case found that the 798 structure was different from the prior art. The Court of Appeals recognizes there were differences from the prior art, but the Court of Appeals held that the difference did not meet the requirements of patentability. The reason upon which this holding was based was that the structure did not produce a new result, the court saying:

> "While perhaps more efficient, the inversion of the parts so as to allow the shank to flex downwardly away from the plate above it did not bring about a

> significantly new or different result, and would have been obvious to a person having ordinary skill in the art."

It is submitted that the Court of Appeals did not consider the trial court's finding as to presumption of validity and in doing so did not give proper effect to the statute 35 U. S. C., Sec. 282. It disregarded Rule 52 of the Federal Rules of Civil Procedure and applied an inappropriate test as to patentability in holding the patent invalid for the reason the structure did not produce a new result. This is in conflict with the requirements of the statute.

C. The Patent in Suit.

The patent in suit is entitled "Clamp for Vibrating Shank Plows." It was issued February 10, 1953 on an application filed August 27, 1951 (Pl. Ex. A; R. 577-587). The clamp is used on a frame beam to connect the upper forward end of a resilient shank thereto with the lower end of the shank carrying a chisel for plowing or other ground working operations. The clamp includes a body member or fixed part that is secured to the frame and a movable part in the form of a plate pivotally connected at its rear portion to the fixed member by a pivot pin with the plate portion extending forwardly or longitudinally to the direction of travel of the plow. The upper forward end of the shank is arranged under the plate portion with the forward end of the shank connected to the forward end of the plate at a substantial distance from the pivotal axis thereof. The structure shown in the patent had a bolt and nut forming the connection between the forward end of the shank and the forward end of the plate. A coiled spring, arranged at the forward end of the body, acts through a nut, washer and spring rod acts on the

shank and plate member to resiliently urge the forward end thereof to a stop engagement with the body to normally hold the shank in plowing position.

In the plowing operations, forces are exerted rearwardly and upwardly on the chisel, and when such forces overcome the force applied by the spring as in striking obstructions, or rocks and the like, the forward end of the shank and plate member will hinge downwardly against the tension of the spring so that the chisel can rise upwardly and move over the obstruction. Plowing forces normally hold the shank against the rear of the plate of the movable part, and when such forces are removed or the chisel removed from the ground, the shank at the rear of the movable part is supported by a stirrup or a loop that embraces the shank adjacent the pivot of the movable part. This loop or stirrup also provides a support for the shank against excessive rebound when the chisel passes over an obstruction. The shank is positively connected to the plate of the movable member only at the forward end of the plate and shank so that the shank can flex for substantially the full length thereof. The support by the loop or stirrup is such that the flexibility of the structure is retained. This flexing of the shank including the portion thereof under the plate portion rearwardly of the bolt and nut connection with said plate portion provides a distribution of stress that is an important feature in preventing damage to the plow structure. If the portion of the shank along the length of the plate portion was rigidly secured thereagainst for substantially the full length of said plate portion, or so held by the forces acting thereon, then the only flexing of the shank would be in that portion extending rearwardly from said plate portion of the movable member with the maximum shank bending stress being located immediately to the rear of said plate portion

and tending to break or cause a permanent set in the shank at that point. Graham in the 798 patent was the first to devise a mounting wherein the shank was positively held to a hinged plate at the upper forward end only and arranged so the shank could flex substantially the full length thereof by flexing or bending away from the plate. This is a bowing of the part of the shank between the bolt and nut at the forward plate portion and the rear end of the plate. This mounting was one wherein the flexing would not be limited by the shank being forced against the plate for the length thereof.

The structures involved in this suit are subjected to extreme shocks. Deere's expert, Mr. Fishleigh, admitted that the forces on the chisel tool could result in forces on the forward ends of the shanks up to 4,000 pounds or so (R. 409). The shock force from the chisel striking a rock applies a force that swings the upper forward end of the shank and plate member downwardly. It bends or flexes the portion of the shank that extends rearwardly from the plate member, but also it tends to flex the portion of the shank that is under the plate member so that it flexes downwardly away from the plate member. This action is shown in the sketches (Pls. Ex. R, S and T; R. 643-645-647). The particular flexing of the forward portion of the shank is shown in the dotted lines on the sketch (Pls. Ex. T; R. 647) as was explained by Graham's expert, Mr. Fenton (R. 570). This flexing was distinguished from that which would occur in the prior art structures (R. 572), an example of which is illustrated on the sketches (Pls. Ex. U, V and W; R. 649-651-653).

In the prior art the shock forces tended to bend the shank against the plate so that it tightened thereagainst preventing flexing in that area with the result that there was more stress in the area of the shank at the rear of the

plate member. In the 798 patent structure the forces tended to bend the shank away from the plate so it could flex in the area along the plate absorbing the shock. The force required for bending the shank away from the plate reduced the stress occurring at the rear of the plate member from that of the prior art structures. While this flexing of the 798 structure is small, it is effective in absorbing the tremendous shock loads and thereby reducing damage that would otherwise occur to the plow structures. This was a particular arrangement of structure that provided a flexing in a shank of chisel plow structures that was not possible with the prior art structures and thereby was a substantial advance in the art.

D. The Respondents' Structures.

While the question of infringement of the 798 patent is not before this court, we believe reference should be made to respondent's structure and their engineer's statements relative thereto that recognize with the arrangement of the shank and plate there are better stress characteristics in operation (R. 113). While respondents give praise to the prior art, they still use the features of the Graham 798 patent, a copy of which they had before them. Deere's spring clamps were designed by their engineer and witness Hunter. He was given the assignment in the spring of 1953 and proceeded to investigate and consider different ways of providing a cushion spring mounting for the shank or standard (R. 94) but with all his engineering ability the clamp he designed, as shown in the drawings (Defs. Ex. 33 (a) and 33 (b); R. 877-879), was considered by Deere's own patent department as an infringement of the Graham 798 patent (Defs. Ex. 32; R. 847). Then the design was modified, the parts were

adapted to be cast instead of fabricated of steel plate, the modified design resulting in the Deere 650 clamp (Pls. Ex. I) which is also shown on a drawing (Defs. Ex. 41, R. 889). Hunter was asked if in that physical exhibit the action would be the same as that of the clamp shown in his original design (Defs. Ex. 33 (b); R. 879) and he stated, "It would be the same action, plowing action" (R. 105). He was then asked if it would be the same movement that would occur in the hinge member and the shank in the structure shown in the Graham 798 patent. His answer was, "Yes, that would be the same action" (R. 105).

Hunter designed the lighter clamp that resulted in the Deere 100 series clamp (Pls. Ex. J). There were drawings (Defs. Ex. 45 (a) and 45 (b); R. 895, 897) showing this second design which the Deere patent department advised would infringe the Graham 798 patent (Defs. Ex. 32; R. 871). Again there were some slight changes that did not change the function and when Mr. Hunter was asked if those minor changes altered the function or positioning of the shank in any manner, his answer was "No, those revisions were so made and the parts proportioned as to maintain the standard in its proper working position" (R. 110). Hunter was questioned as to why in defendant's structure he placed the shank below the hinge member rather than above and his answers were:

> "Q. Can you tell us the reason you place the standard or shank below the hinge member rather than above? A. The resultant forces, resultant loading of the standard into the clamp arrangement is upward and to the rear. By having the standard below the hinge member we are handling compressive forces rather than tensile forces in the members of the clamp.
>
> "Q. And that gives you a much better or more favorable stress arrangement for your standard than

you would have if you place the standard above the plate member of the hinge member? A. We feel that it does (R. 113)."

It is submitted that this shows that respondents recognized the desirability and advantage of the particular arrangement of the parts as shown in the Graham 798 patent. Even though they knew they were only making minor changes from the structure their patent department had considered an infringement of the Graham 798 patent and that the different structure operated substantially in the same way and provided the same result, they apparently felt that that structure was of such merit and desirability that they proceeded to market such structures with full knowledge that they might be called to account for the infringement. It is believed that this tribute by respondents adds support to our contention that the Graham 798 patent was a substantial advance in the art.

This is a case where respondents' Deere, by their engineer's testimony, say the structure is better than the prior art. The engineer had a patent library (R. 56, 95), also surveys of the structures being used in the field which included Graham's and Jeoffroy's (R. 93), and after careful study he made the infringing structure. In effect the respondents are saying, yes the Graham 798 structure is new, it is better. They want to use it, but the invention they infringe, because they covet it, is contended to not involve patentable invention. What is the significance of this coveting of a patented invention and then contending that the patent thereon is invalid? A patent is an incentive reward and is issued to protect for a limited time the originator of that which is new, which provided an advancement, a new or improved result, or effect, or function, or other advantages that the

prior art does not teach how to obtain. The protection is granted to prevent piracy by others for that limited time. The piracy or theft is called infringement of the patent granted, and regardless of the word, it is still stealing. The question arises, what is the reason for the stealing? Is it to derive an advantage? If there is no advantage, either real or imagined, no one steals. When a patent is issued and it is established that the patented subject matter is novel (none of the prior art showed a structure like that of the 798 patent), then by substantially conclusive evidence it is demonstrated that the novel subject matter produces an advantage, the progress (the better application of forces), is the very copying (infringement) by the infringer (Deere) while it is alleging lack of patentable invention as justification of the theft. The most conclusive proof of patentability is the infringement of that which is novel and, in fact, novelty coupled with infringement should be convincing that the invention also provided a progress, a betterment in the art that warrants the holding of the patent valid. The respondents plead the invention is not patentable, but the answer should be, if the prior art is just as good then use it or devise your own novel structure. Don't steal the patentees' and as justification cry there was nothing patentable in the invention appropriated, *Minnesota Mining & Mfg. Co.* v. *Shuger,* 132 F. Supp. 640 (D. Md., 1955); *Guiberson Corp.* v. *Equipment Engineers,* 225 F. 2d 431 (5 Cir., 1958); *Wyott Mfg. Co.* v. *Doran Coffee Roasting Co.,* 160 F. Supp. 644 (D. Col., 1958); *Kurtz* v. *Belle Hat Lining Co.,* 280 F. 277 (2 Cir., 1922).

This is an exceptional example of a case wherein, with full knowledge of the prior art and of the patent in suit, the respondent cast aside those structures that were avail-

able from the prior art because they coveted the advantages that resulted from the advance in the art provided by the Graham invention. They recognized the advance and paid tribute to it by the copying of the features of the 798 structure. *Diamond Rubber Company* v. *Consolidated Rubber Tire Company,* 220 U. S. 428, 441 (1911). This should be most conclusive evidence that the invention of the Graham 798 patent met the statutory requirements for a valid patent; that it was new, novel and it was not obvious at the time the invention was made to a person having ordinary skill in the art and that it represented progress in the art.

E. The Prior Art.

In the trial court respondents urged prior patents and uses, and it was stipulated (Item 7; R. 15) that all of the alleged prior patents and prior uses were before the Court of Appeals for the Fifth Circuit in *Graham* v. *Cockshutt Farm Equipment,* 256 F. 2d 358, wherein the Graham 798 patent was held valid. Some of that prior art was not cited by the Patent Office during examination of the application which issued into the 798 patent, but the trial court in Finding XI (R. 27) found the noncited prior art was similar to some of the patents that had been relied upon by the Patent Office. While the Court of Appeals did not controvert that Finding, a few comments are herein presented in support of the Finding of the trial court. In the trial court the respondents relied upon a number of patents and prior devices as set forth in the trial court's memorandum opinion (R. 18-19). However, in their brief before the Court of Appeals respondents urged only the following patents and alleged prior uses:

United States Patents.

Patent	*Date of Issue*	*Patentee*
211,003	December 17, 1878	Dunbar (R. 745-749)
284,278	September 4, 1883	Cobb (R. 755-757)
287,965	November 6, 1883	Rix (R. 759-761)
2,493,811	January 10, 1950	Graham (R. 717-726)

Foreign Patents.

Danish		
57,391	March 18, 1940	Petersen (R. 727-733)
Australian		
111,910	November 8, 1940	Traeger (R. 735-741)

Prior Uses:

Spring Clamp marketed by Jeoffroy Mfg., Inc., 1948. Designated Jeoffroy SC-580.

Spring Clamp sold by Glencoe Mfg. Co., Inc. Made and tested August, 1949. Offered for sale March, 1950. Sold and delivered May, 1950.

Of the prior patents, the Danish patent of Petersen, Australian patent of Traeger and the Graham 811 patent were all cited and, of course, considered by the Patent Office. The Jeoffroy SC-580 spring clamp was the one that was held to infringe the Graham 811 patent in *Jeoffroy Mfg.* v. *Graham* (5 Cir.), 206 F. 2d 772. It operated in substantially the same manner as the 811 structure and the minor differences did not change the fact that the Patent Office considered such a device in the Graham 811 patent which was cited by it.

The Dunbar Patent, No. 211,003 (R. 745) showed a harrow tooth and one end of a spring clamped together between two plates of a pivoted member mounted on top of a beam with the spring urging the plate portions

downwardly so the tooth would engage the rear of the beam. The tooth was adjustable for depth. A mere glance at the Dunbar drawings reveals that there is no real similarity between the structure thereof and that of the patent in suit. However, in this suit, respondents' expert, Fishleigh, indicated that seven mechanical elements were in various prior art devices and were found in the Dunbar structure (R. 266; 366-369). A comparison of the Dunbar structure with the patent in suit emphasizes that what may be said to be a combination of old elements may be a completely different structure from the prior combination and one that would successfully function where the prior combination would fail. Even a person having no skill in the agricultural art would readily see that the Dunbar structure, while it might scratch the ground, could not plow and withstand forces in the manner of the structure of the patent in suit.

The structures of the patents of Cobb and Rix and the prior use structure of Glencoe are similar to the Danish patent of Petersen which was cited and considered by the Patent Office. Each of these devices have a body portion mounting a pivoted member that includes a plate portion and the shank extends through a loop portion and engages a face of the plate. When each of these devices are used in cultivating or plowing by drawing the lower end of the shank or tool through the soil the resulting force acting on the shank tends to rotate or pivot the plate member. The force applied to the portion of the shank engaging the plate tends to hold that shank tight against the plate surface and actually opposes any flexing of the portion of the shank that extends along the length of the plate portion.

Respondents' expert, Fishleigh, admitted that the relative direction of such force in Glencoe was the same as

in the Graham 811, Petersen, Jeoffroy SC-580, Rix and also Cobb (R. 433). Fishleigh also admitted that this direction of forces relative to the shank and plate was opposite to the direction in the Graham 798 structure. The disclosures of Cobb, Rix, and the clamp of Glencoe being similar to Petersen, and incapable of providing the flexibility of the shank in the portion along the plate member as is obtained by the Graham 798 structure, makes it evident that the Patent Office did consider an example of such prior art and that, therefore, the presumption of validity of the Graham patent in suit is not weakened or destroyed.

This prior art demonstrates that throughout all of the years the Rix disclosure was available, over fifty years, no one, not even those with exceptional skill in the art, seeking to solve the problem of plowing in rocky areas, conceived of a structure wherein the shank would have flexibility for substantially the entire length thereof which includes the portion along the plate of the hinged member. The prior art shows they all followed the same concept. Glencoe, fifty years after Rix, mounted the shank and plate in a manner where the forces in plowing bent the shank in the part along the plate portion, against the plate to hold the same tight and eliminate flexing in that portion, an entirely opposite concept to that of Graham's in his 798 structure. These prior art structures and respondent's urging of them as teaching the patented structure, as well as the respondents' copying, should enforce the conclusion that the Graham 798 structure should be subject of a valid patent.

When the Graham 798 device is compared with the prior art, the comparison shows that it was different. None of the prior art had an arrangement like that of the patented structure and none provided the particular

flexing of the shank. It was new, it was novel, it solved the problem of chisel plowing in rocky areas, therefore it was also useful. The fact that none of those skilled in the art conceived of such a structure through all the years, is evidence that the structure was not obvious. Respondents' engineer admitted that it was a better structure. This betterment was an advance in the art and caused progress in that it was a concept of a mounting that provided a shank flexing that was not even suggested by any of the prior art.

F. The Patent in Suit Meets the Statutory Requirements for Patentability.

A patent is presumed valid by statute, U. S. C. Title 35, Section 282. Also it is well established that that presumption of validity is a rebuttable one and is weakened if prior art is introduced that is more pertinent than that considered by the Patent Office. Defense attorneys can always find prior patents that are not of record in the Patent Office because it would be impractical for a patent examiner to cite each and every patent that might have a bearing on the invention. The patents cited by the Patent Office are selected examples of the prior art. The disclosure by a defendant of non-cited prior art that is merely cumulative, does not weaken the statutory presumption. *Otto* v. *Koppers Co.*, 246 F. 2d 789 at 801 (4 Cir., 1957). The trial court in Finding XI (R. 27) found that the statutory presumption of validity was not weakened or destroyed since the disclosures of the prior art not cited by the Patent Office "are similar to some of the patents relied upon by the Patent Office Examiner." The Court of Appeals did not controvert this finding.

The Court of Appeals in its decision recognized that there was a difference in the structural arrangement in

the 798 patented structure from that of the prior art. Also, it recognized that the 798 structure was perhaps more efficient so that the actual structure was new. The structure was useful because a large number of devices coming under the patent were sold by Jeoffroy, those devices being like the physical exhibits (Plaintiffs' Ex. C, D, and E). Since the structure was new and useful, it met the requirement of Section 101 of the statute. The trial court found that the particular arrangement of the elements disclosed by the 798 patent were not present in any single reference or as a whole (Finding XII; R. 28). All of the prior art brought forth by the defendants in this case was before the court in the Fifth Circuit when that court found the patent valid. *Graham* v. *Cockshutt Farm Equip.*, 5 Cir., 256 F. 2d 358 (Stipulation item 7; R. 15). There was no showing of any of the conditions under Section 102 of the statute that would prevent patentability of the invention and, therefore, the invention met the requirements for patentability and novelty of Section 102.

Was the device shown in the Graham patent No. 2,627,798 a solution to a problem? Was it useful? Was it new? There had been a problem of breakage of plows in a rocky territory and certainly the subject Graham patent was one solution. We do not contend that there might not be other solutions. Entirely different structures probably could be made that could solve the problem and such structures probably could have been devised by Deere's engineers if they had utilized some ingenuity instead of pirating the developments of Graham. Graham's patented structure was useful because it permitted plowing in such rocky country. The devices which came under the patent were admitted to be commercial successes. It did have some old elements but that does not defeat

patentability. *Entron of Maryland, Inc.* v. *Jerrold Electronic Corp.* (*supra*). The Graham patented structure was new. In all of the prior art wherein a chisel shank was mounted for pivotal movement, there was not one that had the arrangement, operation and action of the Graham structure. The Court of Appeals does not point out wherein any of the prior art would teach modifications of other prior art to form a structure such as the Graham patent. It apparently made up its mind as to invalidity when it saw the finding of the trial court that the patented structure provided an improved functional result and in absence of a finding of a new or different result.

As to the third requirement for patentability, as laid down in Section 103 of the statute; namely, relating to non-obvious subject matter, it should be again noted that all of the prior art brought forth in this case by the respondents Deere, including all of the prior patents and the prior devices relied upon by respondents, was before the District Court and the Appellate Court in *Graham* v. *Cockshutt*, 256 F. 2d 358, and the Graham 798 patent was held valid therein. Respondents relied heavily on the Glencoe device as an anticipation, but when they built the infringing devices they did not even consider Glencoe. They copied Graham. In asserting the defense of invalidity, the respondents herein praised the prior art which included the patents of Dunbar, Cobb, Rix and others that had been available to the industry for more than 50 years. Those patents, particularly Rix, showed that persons had been working on the problem for 50 years before Graham filed his patent application. But the prior art merely shows that no one had made or provided a spring clamp such as that of the Graham 798 structure. The respondents did not even attempt to show that they had used the prior art in arriving at their

structure. On the contrary, they followed Graham instead of the prior art (Defendants' Ex. 32; R. 844). To base an argument of obviousness on prior art in this case is to impute fifty years of stupidity to those skilled in the art, *Expanded Metal Co.* v. *Bradford,* 214 U. S. 366, 381 (1909).

In the prior art relied upon by the respondents Deere wherein a chisel shank was mounted for pivotal movement with a portion of the shank extending along a plate member of a hinged shank attaching member, and this included the Danish patent to Petersen, the Glencoe structure, the patents of Cobb and Rix, the arrangement was such that the forces in plowing or striking an object tended to force the shank against the face of the plate portion of said attaching member and to hold it tight thereagainst. In all of these prior art devices, even if there was any bending of the shank in that part lying along the plate, it tended to bend against the plate so that the engagement would resist and eliminate flexing in that portion of the shank. In the prior art, the bend of the shank was against the plate preventing the flexing, while in the 798 patent the shank would bend or bow away from the plate and the shank would flex for substantially the entire length thereof (Pls. Exs. T and W; R. 570-572; 647, 653).

Most of the prior devices had long been available and the recent clamp of Glencoe followed them using the same arrangement that restricted the shock absorbing flexing. It is apparent that no one had conceived that there could be increasing flexing, a flexing for substantially the full length of the shank and a flexing wherein the magnitude thereof would increase with the force applied and thereby resist damage to the structure. This increased flexing and shock absorption was a flexing of the shank relative to the plate portion of the attaching member that was new

and unobvious so that actually even with the so-called "test" or "standard" applied by the Court of Appeals of the Eighth Circuit, there was a new result and the patent should have been held valid. Of course, this was a new result in a portion of the structure, while the overall result was chisel plowing with a spring clamp that would permit the tool to rise up over an obstruction and then return into the ground for continued plowing.

The Court of Appeals also noted that the 798 patent claims did not mention the shank flex. This was the function or result that was not found in the claims or in the specification. There was no holding that the specification was insufficient to teach someone how to build the structure. Obviously, the drawings and specification would teach anyone how to build the structure, and when that is true of the disclosure, the patent has complied with the statute as to disclosure. There is no requirement in the statute that there be any detail or description as to every function or result that will or can be obtained. To suggest that in a patent fully disclosing the claimed structure, the absence of details of function or result in the specification or claims thereof is a proper ground for holding the patent invalid is clearly a basis that is not in accordance with the statute and that is completely contrary to the law.

In the past, many claims have been held improper because they were functional or claimed the result instead of the structure. *Halliburton Oil Well Cementing Co.* v. *Walker*, 329 U. S. 1 (1946); *Refrigeration Patents Corp.* v. *Stewart-Warner Corp.*, 159 F. 2d 972 (7 Cir., 1947); *Parker Appliance Co.* v. *Irvin W. Masters, Inc., et al.*, 94 F. Supp. 72, Aff. 193 F. 2d 180 (9 Cir., 1951). In the present case, the patentee has described the structure and claimed the structure and the Court of Appeals for the

Eighth Circuit has held the patent invalid because it did not do exactly what has been condemned through the years.

There was no finding by the Court of Appeals that any prior art device was like that of the patent. There was no finding that any of the prior art had the same action. There was no finding that the patented structure would not produce a better result or the same result in a more economical facile manner. There was only the finding of the Court of Appeals that there was an improper test used by the trial court; namely, that the trial court did not find any new result. The Court of Appeals disregarded the requirements of the statute that a patent disclose the structure. It disregarded the requirement that the claims specify the structure. It held that the failure of the specification and claims to spell out function and result was a fatal defect and, therefore, the patent was invalid. It is submitted that this is going to the ultimate of extremes to hold a patent invalid. It is submitted that the patent in suit meets the statutory test for patentability and that it should be held valid.

CONCLUSION.

In conclusion we submit that it is important that all litigants have the questions of patent validity be uniformly determined according to law. It is important that the patent statutes be interpreted properly by this Court and that patentability be determined in accordance with the statues and not by some test or standard having requirements that are outside of the statute or that have been eliminated by the statute. It is, therefore, respectfully submitted that in this case this Court, by the exercise of its supervisory powers, should remove the conflict of decisions between the Fifth and Eighth Circuits and

establish unequivocably that a new result and prior judicial tests are not requirements for patentability under the statute.

It is respectfully submitted that the United States Court of Appeals for the Eighth Circuit erred in its arriving at decision in this case, by applying a test as to patentability that was contrary to the statute and that its decision should be reversed and that of the trial court reinstated.

Respectfully submitted,

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